



UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents  
United States Patent and Trademark Office  
Washington, D.C. 20231  
www.uspto.gov

Paper No. 16

GERSTEIN E. NOLAND  
MARSHALL O'TOOLE GERSTEIN MURRAY & BORUN  
6300 SEARS TOWER  
233 SOUTH WACKER DRIVE  
CHICAGO IL 60606-6402

**COPY MAILED**

**JUN 2 1 2004**

**OFFICE OF PETITIONS**

In re Application of  
Colin D. MacCalman  
Application No. 09/830,811  
Filed: August 30, 2001  
Attorney Docket No. 27866/37317

:  
:DECISION DISMISSING PETITION  
:UNDER 37 CFR 1.78(a)(3) AND  
:UNDER 37 CFR 1.78(a)(6)  
:

This is a decision on the petition filed November 25, 2003, which is being treated under 37 CFR 1.78(a)(3) and 1.78(a)(6), to accept an unintentionally delayed claim under 35 U.S.C. § 365(c) for the benefit of prior-filed PCT Application No. PCT/CA99/01057, filed October 29, 1999 and Provisional Application No. 60/106,258, filed October 30, 1998, set forth in the amendment filed with the instant petition.

The petitions are **dismissed** as moot for the reasons stated below.

A petition for acceptance of a claim for late priority under 37 CFR 1.78(a)(3) is only applicable to those applications filed on or after November 29, 2000.

37 CFR 1.78(a)(2)(ii)<sup>1</sup> indicates that the time periods set forth therein do not apply if the later-filed application is: (1) an application for a design patent; (2) an application filed under 35 U.S.C. § 111(a) before November 29, 2000; and (3) a **nonprovisional application which entered the national stage after compliance with 35 U.S.C. § 371 from an international application filed under 35 U.S.C. § 363 before November 29, 2000.**

---

<sup>1</sup> 37 CFR 1.78(a)(2) was amended to place its provisions in separate paragraphs (a)(2)(i) through (a)(2)(iv) for clarity. **See Requirements for Claiming the Benefit of Prior-Filed Applications Under Eighteen-Month Publication of Patent Applications**, 66 FR 67087 (December 28, 2001); 1254 Off. Gaz. Pat. Office, 121 (January 22, 2002) (final rule).

Since the instant nonprovisional application is the national stage entry of an international application filed prior to November 29, 2000, the provisions of 37 CFR 1.78(a)(3) for acceptance of a late claim for priority do not apply to the subject nonprovisional application. Accordingly, the petition is dismissed as involving a moot issue.

According to MPEP 1893.03(c), page 1800-149, a national stage application filed under 35 U.S.C. § 371 may not claim benefit of the filing date of the international application of which it is the national stage since its filing date is the date of filing of that international application. See *also* MPEP 1893.03(b). Accordingly, it is not necessary for the applicant to amend the first sentence of the specification to reference the international application number that was used to identify the application during international processing of the application by the international authorities prior to commencement of the national stage under 35 U.S.C. § 371. Therefore, the amendment filed with the instant petition will not be entered.

As to the petition under 37 CFR 1.78(a)(6):

Since the benefit claim for intermediate PCT Application No. PCT/CA99/01057, filed October 29, 1999 was dismissed, the provisional Application No. 60/106,258 filed October 30, 1998 would be filed well over twelve months from the filing date of the instant application, Application No. 09/830,811, filed August 30, 2001.

The 1,330 petition fee submitted with the instant petition will be refunded to Deposit Account No. 13-2855 in due course.

Any inquiries concerning this decision may be directed to the undersigned at (703) 305-8859.

This application is being forwarded to Technology Center Art Unit 1635.



Karen Creasy  
Petitions Examiner  
Office of Petitions  
Office of the Deputy Commissioner  
for Patent Examination Policy